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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/617,048 | 07/11/2003 | Terry Van Liew | 237688US0 | 3057 |
| 22850 | 7590 | 05/08/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | WOODWARD, ANA LUCRECIA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/617,048 | Applicant(s) LIEW ET AL. | |
| | Examiner Ana L. Woodward | Art Unit 1711 | |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/2/2006
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 9-13, 27, 30, 33 & 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 14-26, 31, 32 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I comprising the ultimate species of nylon-611/dimethicone copolymer and isododecane in the reply filed on March 28, 2005 is acknowledged. The traversal is on the ground(s) that the Office has not shown that a burden exists in searching all of the claims. This is not found persuasive because contrary to applicants' contention, not only is the search required group II, containing an additional polymer derived from ethylenic reactants, *not* required for group I but it would add to the already serious and burdensome search required for the plurality of different composition embodiments encompassed by claim 1. In any event, applicants have not submitted evidence or identified such evidence now of record showing the species to be obvious variants or clearly admitted on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 6, 7, 9-13, 27-30, 33 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species or group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 28, 2005.

Claim Rejections - 35 USC § 112

3. Claims 1-5, 8, 14-26, 31, 32 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "structuring" is indefinite as to scope and meaning.

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In claim 1, line 8, it is unclear if or how the redundant language “and combinations thereof” limits the Markush group recitation in light of the antecedently recited “at least two groups” terminology.

In claims 2, 3, 8 the objectionable terms “possibly”, “preferably” and/or “better still” renders the metes and bounds of the claimed subject matter indefinite.

In claim 2, line 2 of 2), “alkylenediyl” is indefinite as to scope and meaning.

In claim 2, line 3 of 3), it is unclear as to whether or not the substituent defined by the language “bearing as substituent one of the following atoms or groups” is required in the Y group.

In claim 3, no express antecedent basis can be seen for “C₅₆” branched alkylene groups with or without ‘rings and unconjugated unsaturations’.

In claim 3, no express antecedent basis can be seen for alkylene groups “comprising from 1 to 5 amide groups”.

In claims 4 and 5, it is unclear as to whether the recited moieties are in addition to the moiety per claim 2.

In claim 4, lines 5 and 7, there is no express antecedent basis for formula “(I)”.

In claim 4, it is unclear what “or a phenyl group substituted with one or more...alkyl groups” is qualifying.

In claim 8, line 2, “n-C₃H₇” is not understood.

In claims 14 and 15, it is unclear as to whether or not the recited “further” moieties are referring to a moiety other than the “at least two groups” per the base claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 8, 14-26, 31, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,051,216 (Barr et al) in view of US 6,376,078 (Inokuchi).

Barr et al disclose cosmetic compositions comprising siloxane-based polyamides, reading on the presently claimed structuring polymer, silicone fluids and solvents, reading on the presently claimed oil, and additional ingredients, embracing the presently claimed silicone elastomer component. The siloxane-based polyamide of formula A encompasses applicants' nylon 6-11/dimethicone copolymer (column 4, lines 40 et seq). The optimal molecular weight for said copolymers ranges from 4,000 – 50,000. Suitable silicone fluids and solvents include dimethicones, etc. (column 12, lines 35-51, etc.). Suitable additives include silicone gums and elastomers, as well as colorants (column 14, lines 42-57). The composition can be in the form of a gel or stick.

In essence, the disclosure of the reference differs from the present claims in not expressly disclosing silicone elastomer particles comprising silicone rubber core coated with silicone resin. Silicone elastomer particles having a core-cladding structure, as presently claimed, are well known in the art as useful additives for cosmetic compositions, e.g., as extenders, lubricity improvers, water repellant agents (per Inokuchi). Accordingly, it is maintained that it would have been obvious to one having ordinary skill in the art to have employed a silicone elastomer

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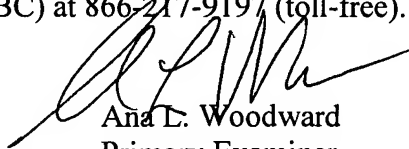
having a core-cladding structure for its attendant properties, as per Inokuchi, in the composition of Barr et al. This is because by being silent relative to the specifics of the silicone elastomer additive, Barr et al implicitly suggests that any silicone elastomer can be used. Absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward
Primary Examiner
Art Unit 1711
